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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,617	12/24/1998	EUGENE M. JOHNSON	6029-7976	3176

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EXAMINER

HAYES, ROBERT CLINTON

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 07/15/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/220,617

Applicant(s)  
Johnson et al

Examiner  
Robert C. Hayes, Ph.D.

Art Unit  
1647



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 26, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10, 12-14, 28, 29, 34-36, and 41-45 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 13, 14, 34-36, 41, and 43-45 is/are rejected.
- 7) ☒ Claim(s) 12, 28, 29, and 42 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Jun 29, 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 28
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

Art Unit: 1647

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group I C (claims 10-15, 28-30 & 34-40; as it relates to SEQ ID NO:203) in Paper No. 26 is acknowledged. The traversal is on the ground(s) that SEQ ID NO:203 "is representative of the genus of sequences claimed", and that "references to non-human sequences and duplicative sequences" have been removed. Because of the amendment of the claims in Paper No: 27 as suggested by the examiner, and because of Applicants' explanation of where the sequences claimed are exactly represented in the larger generic sequence claimed, all pending claims 10, 12-14, 28-29, 34-36 and new claims 41-45 will be examined.

### ***Drawings***

2. New formal drawings are required in this application because Figure 20a & 20b has been changed without a substitute formal drawing itself being submitted (i.e., paper #19, amdt G). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 1647

***Allowable Subject Matter***

3. Claims 12, 28, 29 & 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10, 13-14, 34-36, 41 and 43-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 15 & 18-19 of U.S. Patent No. 6,403,335 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the encoded murine and rat reference persephin amino acid sequences within claim 1 of '335 are approximately 80% identical to the reference persephin amino acid sequence encoded by the human nucleic acid/polynucleotide of claims 10

Art Unit: 1647

& 34 (e.g., see Table 1 of the instant application), which further encode polypeptides that comprise the identical backbone sequence as recited in the base claims of both '335 and the current application. Thus, nucleic acid/polynucleotide molecules encoding persephin polypeptides of "at least 75% sequence identical with SEQ ID NO:223" or 221 encompass claims 1-7 of '335 (i.e., as it relates to claims 10 & 34), in which claims 13, 14, 35, 36 & 44-45 that are further directed toward vectors and isolated host cells and methods of recombinantly producing such persephin polypeptides encompass claims of 8, 9 & 15 of '335. Likewise, the fully complementary sequences of claims 18-19 of '335 are encompassed by claims 41 and 43 of the instant application.

### *Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.

July 10, 2003

*per. 22*